(3)

No. 07-150

FILED
SEP 18 2007
OFFICE OF THE CLERK
SUPREME COURT, U.S.

IN THE

Supreme Court of the United States

NOURI E. HAKIM,

Petitioner,

v.

CANNON AVENT GROUP, PLC, CANNON RUBBER LIMITED AND AVENT AMERICA, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

MORRIS E. COHEN
Counsel of Record
LAW OFFICE OF
MORRIS E. COHEN, P.C.
1122 Coney Island Avenue
Suites 216-217
Brooklyn, New York 11230
(718) 859-8009

Counsel for Petitioner

Of Counsel:

JOSEPH D. GUERRIERO
LUV N' CARE, LTD.
3030 Aurora Avenue
Monroe, Louisiana 71201

211155

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

CORPORATE DISCLOSURE STATEMENT

Petitioner's Corporate Disclosure Statement was set forth at page *ii* of its Petition for a Writ of Certiorari, and there are no amendments to that Statement.

TABLE OF CONTENTS

Page

CORPORATE DISCLOSURE STATEMENT i

TABLE OF CONTENTS ii

TABLE OF CITED AUTHORITIES iii

SUMMARY OF ARGUMENT 1

ARGUMENT 2

I. Petitioner's Argument That the Court of Appeals Has Not Followed the Claim Construction Principles of this Court Stands Unrebutted 2

CONCLUSION 9

TABLE OF CITED AUTHORITIES

Page

Cases:

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. 722 (2002) 4, 7

Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) 3

Seachange, Int'l, Inc. v. C-COR, Inc., 413 F.3d 1361 (Fed. Cir. 2005) 3

Smith v. Snow, 294 U.S. 1 (1935) 3, 4, 5, 6

SUMMARY OF ARGUMENT

The present case concerns the principles of claim construction required by this Court's precedent. In patent law, no question is more important – claim construction affects the litigation of every patent in the United States. Currently, however, claim construction at the Court of Appeals is thoroughly unpredictable and is not constrained by a coherent or uniform view of this Court's precedents.

Respondents confirm this by failing to address any of the claim construction principles of this Court cited in Petitioner's brief. Respondents provide no real support in the record that any of those construction principles – at all – were followed, or even addressed, for the invert limitation.

Likewise, for the opening limitation, Respondents' attempt to justify the Court of Appeals' newest rule of prosecution disclaimer is an empty one. Respondents set forth a fanciful perspective as to the prosecution of Hakim's patents, which recasting is intended to demonstrate that a hole is not an opening. Their spin, however, did not address any of this Court's legal principles of construction cited in Petitioner's brief, the principles actually applied by the Patent Office during prosecution of the patent, or the applicable statutory and regulatory provisions.

By their silence on the relevant legal issues, Respondents only confirm the Court of Appeals' failure to adhere to the claim construction principles required by this Court's caselaw. That failure increases the unpredictability of patent litigation. It further leads to generally absurd results, and can only be corrected by issuance of guidance regarding the hierarchy of principles required in the interpretation of patent claims, as rooted in a systematic view of this Court's long-standing precedent.

ARGUMENT

I. Petitioner's Argument That the Court of Appeals Has Not Followed the Claim Construction Principles of this Court Stands Unrebutted

The issue of claim construction is not only compelling, it is currently the most important topic in modern patent jurisprudence. Claim construction is an essential threshold step in every single case of patent infringement and invalidity litigated in the United States. The lack of any predictability in claim construction affects not just some, but all issued patents, and affects every industry that relies upon patent protection to protect its innovations from piracy and illegal copying.

Petitioner's brief outlined the various evidentiary underpinnings required by this Court's precedent as part of the claim construction process. It also demonstrated that the Court of Appeals follows no systematic, uniform approach to claim construction that would yield predictable results. Respondents' brief only confirms this.

For example, Respondents were not able to reference any real analysis of the "invert" limitation in the lower court decisions. There was no construction of that crucial term with reference to the specification, the contrast with other claims (which lack the invert limitation), the prior art, or anything else.

Indeed, Respondents' self-serving argument that the only evidence regarding this limitation was in an expert declaration is transparently wrong. The specification of the patent itself shows the invert limitation, as illustrated, for example, in the color-coded figures appended to Petitioner's brief. *See,* App. 70a. Likewise, under the doctrine of claim differentiation, the differences between the claims themselves also show the importance of the invert requirement, as some claims recite it

and others do not. *See e.g.*, '931 patent claim 10 (App. 62a) vs. claim 8 (App. 62a).

Claim construction is an essential first step in any patent case — the meaning of the claims *must* be ascertained to determine if they are valid or infringed. *See e.g., Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 374 (1996). But here, claims with the invert limitation were all invalidated without any thoughtful discussion of what the limitation even means or whether it was or was not in the prior art.

Indeed, Respondents have not pointed to any meaningful judicial analysis of the invert term in any form at all. Rather, the district court opined that the exact term used in the claims doesn't matter(!) (App. 30a) and the Court of Appeals upheld. A worse summary of the demands of over a hundred and fifty years of this Court's claim construction jurisprudence is not even possible.

The lack of adherence to this Court's principles likewise holds true for the "opening" and "slit" limitations. This Court has mandated that each claim of a patent must be analyzed in light of the other claims. If a term is set forth in one claim but omitted from another, the claim with the omission may not be limited as if the term were there. *See, Smith v. Snow*, 294 U.S. 1, 13-14 (1935); *See also,* Petition at 5, 16 (discussing this principle, which is also known as the doctrine of claim differentiation).

Respondents do not reference any language in the Court of Appeals' decision that conducted such a differential analysis, or that even addresses this principle with respect to the "opening" and "slit" terms. Rather, they claim it "well settled" that the doctrine of claim differentiation is "merely a guideline" that is trumped by prosecution disclaimer, citing the Federal Circuit's decision in *Seachange*. Respondents' Brief at 12, citing *Seachange, Int'l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1369 (Fed. Cir. 2005).

The claim construction requirements of this Court, however, are not mere "guidelines" that are "trumped" by Federal Circuit rules to the contrary. In *Smith*, this Court ruled that an obviously intended contrast in the words of different claims points to a difference in purpose and meaning. *Smith*, 294 U.S. at 13-14. In *Festo*, this Court likewise ruled that amendment of the claims itself emphasizes the difference between the older and newer versions. *See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 736 (2002). The Court of Appeals is not free to disregard binding precedent of this Court, no matter how "well settled" its error.

Furthermore, Respondents' brief presents a very fanciful and confusing approach to the facts of this case and the prosecution history in an attempt to completely sidestep the actual legal issues here. Their approach avoids all of the construction principles and evidentiary requirements of this Court's precedent so as to support a construction that a hole isn't an opening. But even if there were such an alternate and illogical construction, it is irrelevant. As this Court held in *Smith*, if a claim is susceptible of two constructions, the broader one must be adopted, not a fatal, narrow one.[1] Moreover, under *Smith*, claim differentiation trumps allegations of prosecution disclaimer, not the other way around.[2]

---

1. *See, Smith*, 294 U.S. at 14 ("If the matter were doubtful, it is plain from what has been said that the character of the patent and its commercial and practical success are such as to entitle the inventor to broad claims and to a liberal construction of those which he has made. In such circumstances, if the claim were fairly susceptible of two constructions, that should be adopted which will secure to the patentee his actual invention, rather than to adopt a construction fatal to the grant") (internal cites omitted).

2. *See e.g., Smith*, 294 U.S. at 16 ("It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of the broader Claim 1"). Here, the Patent Office initially rejected narrow claims to a slit and other (Cont'd)

Again, however, the Court of Appeals gave no weight to that precedent. In fact, Respondents' confused discussion is meant to distract from the complete absence in their brief of any reliance on, or response to, the controlling claim construction principles of this Court cited by Petitioner.

As a further example, this Court has established that the claims of a patent *must* be interpreted in light of the patent's specification. *See e.g.*, Petition at 5, 17-18. Hakim showed that his construction and reading of the prosecution history was completely consistent with the specification definition, which states that an opening includes a hole.

There too, Respondents failed to provide any reference that the Court of Appeals even addressed the specification definition, because the court did not.[3] That principle is another sidestepped by Respondents in their brief. Respondents are glaringly silent

---

(Cont'd)
claims reciting an opening. In response, the patentee filed remarks regarding the benefits of a slit, which was followed by allowance of the application by the Patent Office. The patentee then abandoned that application, choosing not to have it issued as a patent. Instead, he filed a continuation in which the he stated that he wanted all of the claims to recite an opening, and that an opening is broader than a slit (and therefore by implication not limited to a slit). The Patent Office then allowed the broader claims. That latter allowance after the patentee's statement demonstrates that the Patent Office was not relying on the earlier remarks regarding a slit to allow the claims. Under *Smith*, the fact that arguments were made regarding the benefits of a slit at a time when numerous narrow claims of the patent recited one has no bearing on the allowance of the subsequent broader claims – claims which were specifically broadened to remove the slit limitation from all of them.

3. There is likewise a complete absence of any reference to where any of the evidentiary underpinnings required by this Court, whether the specification, claim differentiation, or plain meaning, are analyzed or even addressed in the Court of Appeals' decision, because none of those requirements were addressed.

on the issue of the specification because the Court of Appeals gave that mandatory principle of this Court absolutely no weight.

In fact, the prosecution history is entirely consistent with the specification.[4] The failure to rely upon the specification allows fundamental inconsistency within a single integrated written instrument, such that the patent specification and claims unnecessarily contradict each other. Here, for example, it improperly limits the term opening to a slit, when the specification reads to the contrary, and the prosecution history states that the claims were explicitly broadened so that they would not be limited to a slit.[5]

---

4. In the full context of the prosecution history, it is clear that the Patent Office allowed the claims both before and after they amended, whether or not they contained a slit, because the early remarks regarding the slit were unnecessary for patentability. The slit, and the earlier remarks regarding it, were unnecessary in the Patent Office's view since no prior art showed a no-spill cup with a blocking element. The blocking element was a characteristic of each and every claim that the Patent Office ever allowed. In contrast, claims were allowed regardless of whether or not they recited a slit therein. The Court of Appeals, however, completely missed this distinction because it did not conduct the analysis of the prior art required by this Court, which would have further demonstrated that a narrow reading of the claims was unnecessary and unwarranted. *See e.g., Smith*, 294 U.S. at 16. Nothing in the Court of Appeals' decision shows any basis in the prior art itself requiring that the claims of Hakim's patent be limited to a slit, or cites any specific evidence that the prior art teaches no-spill cups with a membrane that inverts.

5. "Applicant is entering minor changes to Claims 1-2 to claim "an opening" as opposed to "a slit", and to recite "a slit" in dependent claims thereto. This change slightly *broadens* the scope of the first two claims. However, both claims still present patentable subject matter; the other independent claims previously recited an opening and all of those claims were deemed to be patentable." *See*, A0264 (emphasis added). As discussed above in fn. 4, the claims were expressly broadened and were repeatedly allowed by the Patent Office regardless of whether or not they contained a slit, demonstrating that the slit limitation, and remarks relating thereto, were never deemed necessary for patentability.

In short, Respondents' brief demonstrates that the Court of Appeals did not give the critical evidentiary underpinnings of this Court's precedent any weight. Nor have Respondents addressed the principles applied by the Patent Office during examination, or the applicable statutory and regulatory provisions. Those principles and provisions are consistent with this Court's precedent but are totally inconsistent with the Court of Appeals' decision, which is silent about them. *See e.g.*, Petition at 18.

Furthermore, while Respondents dispute that the rule of prosecution disclaimer established is a new one, the cases they cite do not support their position. Respondent has cited no precedent of this Court requiring that a patentee who *removes* a limitation should nonetheless have the claims limited to the prior remarks regarding that limitation. Yet that is exactly the outcome of the Federal Circuit's decision – it now retroactively requires that an express disclaimer of prior arguments regarding a claim limitation need have been entered in previously issued patents, even if the limitation was deleted from the claim.

As Petitioner pointed out, this new rule is contrary to the principle in *Festo* that amendment of the claims is itself an emphasis of the difference between the old and new versions of the claim (Pet. at 21). The precedent in *Festo* is also not addressed by Respondent. *Festo,* 535 U.S. at 736 (2002).

Moreover, Respondent's position plainly conflicts with common sense. A patentee's express removal of a limitation from a claim (such as the "slit"), is totally inconsistent with any intent to be limited to the scope of prior remarks regarding the benefits of that limitation ("the slit").

It is extremely common for limitations to be removed by amendment during prosecution of patent applications or continuations thereof. Consequently, the Federal's Circuit's latest rule completely undermines the value of all of the patents prosecuted and issued at a time when no such rule was in effect.[6] Moreover, the Court of Appeals has shown its willingness to apply this new rule even when the results it generates are contrary to those produced by the established claim construction principles of this Court.

Indeed, as Petitioner has explained – and as Respondents have also not rebutted – it is relatively rare for the Federal Circuit to view any claim construction issues through the lens of this Court's precedent. Simply stated, the Court of Appeals follows no coherent, uniform, binding framework providing *predictable* guidance as to the ultimate interpretation of terms in patent claims. This underscores the importance of explicit direction from this Court as to the overriding principles that must be followed in claim construction.

The need for a modern ruling by this Court on the hierarchy that must be followed within the established rules of construction is essential, so that claim construction is predictable both in general and when competing principles produce different results. This case directly illustrates the interplay of all of the relevant principles of construction and their associated evidentiary underpinnings, or lack thereof. It is, therefore, a very apt vehicle for such a ruling, providing guidance for future cases. Without such guidance by this Court, the illogical and unjust morass that is the current state of claim construction will only continue.

---

6. In fact, the Court of Appeals' rule is contrary to its own precedent that was in effect when the claims were prosecuted (Pet. at 21).

CONCLUSION

As a result, for the foregoing reasons and those previously stated in Petitioner's initial brief, it is respectfully submitted that the petition for *certiorari* should be granted.

Respectfully submitted,

MORRIS E. COHEN
Counsel of Record
LAW OFFICE OF
MORRIS E. COHEN, P.C.
1122 Coney Island Avenue
Suites 216-217
Brooklyn, New York 11230
(718) 859-8009

Counsel for Petitioner

Of Counsel:

JOSEPH D. GUERRIERO
LUV N' CARE, LTD.
3030 Aurora Avenue
Monroe, Louisiana 71201